

UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF MASSACHUSETTS

BIS Advanced Software Systems, Ltd., )  
)  
Plaintiff, )  
)  
v. )  
)  
Red Bend Software, Inc., *et al*, )  
)  
Defendants. )  
\_\_\_\_\_ )

Civil Action No. 04-11960-RWZ

**RESPONSE TO RED BEND'S MOTION TO STAY SCHEDULING ORDER**

Plaintiff BIS Advanced Software Systems, Ltd. ("Plaintiff") submits this response to Red Bend's motion to stay the existing scheduling order deadlines.

On December 1, 2005, Plaintiff filed a motion to dismiss, which included a covenant not to sue. (*See* D.I. 60.) The motion specifically requested that the Complaint be dismissed with prejudice, and that Red Bend's declaratory judgment Counterclaims of non-infringement and invalidity be dismissed without prejudice. In the covenant not to sue, Plaintiff agreed not to sue any named Defendant based upon Red Bend's currently available products. As such, Red Bend no longer has any reasonable apprehension of suit, and there is no longer any basis for declaratory judgment jurisdiction.

Red Bend's opposition to Plaintiff's motion to dismiss is based on the false premise that, in these circumstances, "[t]his Court has discretion in whether to allow a declaratory judgment action." (*See* D.I. 62, p. 11.) The terms of the Declaratory Judgment Act, though, are clear that if there is an "actual controversy" then the court's exercise of declaratory judgment jurisdiction is discretionary. 28 U.S.C. § 2201. Conversely, if there is no actual controversy, then the declaratory judgment counts must be dismissed for lack of jurisdiction. *See Super Sack Mfg.*

*Corp. v. Chase Pkg., Corp.*, 57 F.3d 1054, 1056 (Fed. Cir. 1995); *see also Intellectual Prop. Dev., Inc. v. TCI Cablevision of Calif., Inc.*, 248 F.3d 1333, 1342 (Fed. Cir. 2001). Recently, in a similar case, this Court held that the patentee's covenant not to sue extinguished the requisite actual controversy, and dismissed the declaratory judgment counts. *See In re Columbia Univ. Patent Litig.*, 343 F. Supp. 2d 35, 42-43 (D. Mass. 2004).

Accordingly, Red Bend's motion to stay the scheduling order should be denied as moot, and Plaintiff's motion to dismiss should be granted.

Respectfully submitted,

/s/ Scott McConchie

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